



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,078	07/02/2001	Chikako Tsuchiyama	ASA-1012	9093

24956 7590 01/19/2007
MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C.
1800 DIAGONAL ROAD
SUITE 370
ALEXANDRIA, VA 22314

EXAMINER

SHIFERAW, ELENI A

ART UNIT	PAPER NUMBER
----------	--------------

2136

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/895,078	Applicant(s) TSUCHIYAMA ET AL.	
	Examiner Eleni A. Shiferaw	Art Unit 2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-34 is/are rejected. *
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/20/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/20/2006 has been entered.

2. Claims 26-34 are pending.

Claim Objections

3. Claims 26-28 and 32-34 are objected based on the following reasons.

Claim 26 are objected to because these claims recite the limitations "previously stored" in line 15. It does not specify where public key is previously stored. It could be stored in a storage unit, in the image mark, or web page, or etc... Since applicant claims, "a storage unit storing a public key ..." in claim 29, the Examiner rejected claim 26 based on claim 29. Appropriate correction is required in response to this Office action.

Claim 32 is objected based on the same reason above. Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2136

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 26-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scott et al. USPN 6,338,094 B1 in view of Downs et al. US 6,226,618 B1).

Regarding claims 26, 29, and 32, Scott et al. discloses a method/apparatus/medium comprising:

a receiving unit for receiving a web page to which an image mark is attached, the image mark embedding electronic watermark information means of electronic watermark techniques (col. 4 lines 31-60 and col. 5 lines 38-49; *user interface device/network computer/set-top box web page/display banner advertisement link/image mark embedding watermark info.*);

a display unit for displaying information (fig. 2 element 25); and

a control unit for extracting the electronic watermark information embedded in the image mark when recognizing the image mark attached to the web page (col. 5 lines 38-col. 6 lines 15), displaying said image mark on the display of said data terminal, and displaying, on the display of said data terminal (fig. 4 element 69), a menu as to said information that is desired to be disclosed, and if the menu is selected, then displaying said information that is desired to be disclosed embedded in the image mark (col. 7 lines 4-55).

Scott et al. fails to disclose the electronic watermark information comprising expiration information, and signature information; and decoding signature information using public key, and authenticating based on expiration information and signature information to display data.

However, Downs et al. discloses the electronic watermark information including information that is desired to be disclosed by an information exhibitor, information as to an

Art Unit: 2136

expiration term to be used to control display of said information that is desired to be disclosed (col. 11 lines 51-52, col. 24 lines 65-col. 25 lines 36, col. 9 lines 32-38, col. 52 lines 59-67) and information as to electronic signature to be used to conduct verification of authenticity of both said information that is desired to be disclosed and said information as to the expiration term (col. 24 lines 65-col. 25 lines 36 and col. 11 lines 51-52);

a storage unit storing a public key for decoding said information as to electronic signature (col. 34 lines 33-42, and col. 12 lines 37-44; *stored public key to verify digital signature and the well-known content control using digital signature, watermarking, certificate...*);

decoding the information as to electronic signature of the data extracted by using the public key stored in said storage unit (col. 32 lines 43-48, col. 44 lines 9-12, and col. 13 lines 67-col. 14 lines 27; *decoding extracted signature public key stored*), verifying the authenticity of both said information embedded in the image mark, both said information being information that is desired to be disclosed and said information as to the expiration term by using the information as to electronic signature thus decoded (col. 34 lines 39-41, col. 40 lines 65-68, col. 14 lines 38-45, and col. 44 lines 6-41; *verifying content and expiration date of the content*), comparing the information as to the expiration term with information as to a clock of said data terminal (col. 14 lines 19-27, col. 34 lines 55-col. 35, and col. 40 lines 65-68; *authenticating and verifying using expiration date of the content*); and

displaying said image mark (*watermarked/embedded content*) on the display of said data terminal if a current time obtained from said information as to the clock falls within said expiration term represented by said information as to the expiration term (col. 21 lines 43-58 and

col. 59 lines 55-59; *usage condition/expiration date/term of content is verified first before rendering the desired watermarked content*).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to employ the teachings of Downs et al. with in the system of Scott et al. because they are analogous in content distribution and watermarking. One would have been motivated to incorporate the teachings of including the expiration date and signature in the watermark because it is well known at the time of the invention as Downs et al. discloses any kind information can be embedded and/or included in the watermark and it authenticate data based on embedded information.

Regarding claims 27, 30, and 33 Scott et al. further teaches the data display method/apparatus wherein, if it is judged that the authenticity is lower than a predetermined level in said step of verifying authenticity, said image mark is not displayed on this display (col. 8 lines 14-31 and fig. 7).

Regarding claims 28, 31, and 34 Scott et al. further teaches the data display method/apparatus wherein said information that is desired to be disclosed includes information as to a location at which detailed information of said data embedded in said image mark exists (claim 1 and fig. 7).

Conclusion

Art Unit: 2136

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shin 7047410 B1 col. 5 lines 40-52 discloses watermark comprising signature information and authentication.

NPL: "Embedding a Seal into a picture under Orthogonal Wavelet Transformation" 1996 IEEE, how to embed a signature seal to a picture.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eleni A. Shiferaw whose telephone number is 571-272-3867. The examiner can normally be reached on Mon-Fri 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser R. Moazzami can be reached on (571) 272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 09/895,078


Page 7

Art Unit: 2136

January 16, 2007

38

NASSER MOAZZAMI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100


1/16/07